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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,701	07/31/2003	David Wong	13914-028001 / 2003P00198	3616
32864	7590	11/23/2004	EXAMINER	
FISH & RICHARDSON, P.C. 3300 DAIN RAUSCHER PLAZA 60 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/632,701	WONG, DAVID	
	Examiner	Art Unit	
	Charles R Kyle	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-15 are is rejected under 35 U.S.C. § 101 because, the claimed invention is directed to a non-statutory subject matter. Specifically the method claim as presented does not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

“A computer implemented method for ---”, or something similar. Also, in the body of the claim include at least one structural / functional interrelationship which can only be computer implemented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 9, 12, 15-18, 20, 24, 27-29, 31 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0083156 A1 *Schultze*.

With respect to Claim 1, *Schultze* discloses the invention as claimed including in a method the steps of:

receiving user input to generate an opportunity representing a desired commercial transaction, the user input including opportunity data associated with the desired commercial transaction (Para. 21);

receiving user input to associate a particular compliance rule with the opportunity, the user input specifying a particular response attribute of a plurality of response attributes to be evaluated according to the particular compliance rule, the user input further specifying the particular compliance rule of a plurality of pre-defined compliance rules (Paras., 23, 30);

communicating the opportunity to a potential supplier (Para. 33);

receiving a response from the potential supplier, the response including response attribute data for the particular response attribute (Paras. 7, 23); and

evaluating the response attribute data for the particular response attribute using the particular compliance rule (para.38).

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With respect to Claims 2 and 3, *Schultze* discloses a flagging action based on a response at Fig. 6, ele. 515 and para. 38.

With respect to Claim 5, *Schultze* discloses discarding a response at para. 38.

As to Claim 9, *Schultze* discloses winner determination at Fig. 4, ele. 355 and para. 35.

With respect to Claim 12, *Schultze* discloses the invention as claimed including in a method the steps of:

receiving user input specifying a particular response attribute of a plurality of response attributes to evaluate using a compliance rule (paras. 30-31);

receiving user input specifying a particular compliance rule of a plurality of pre-defined compliance rules to evaluate attribute data for the particular response attribute (paras. 22-24); and

receiving user input specifying an action to take based on evaluating the attribute data using the particular compliance rule (para. 38).

With respect to Claim 15, see the discussion of Claims 1 and 12.

With respect to Claims 16 and 27, they are the article and system forms of Claim 10 respectively and are rejected in a like way.

With respect to Claims 17 and 28, they are the article and system forms of Claim 2 respectively and are rejected in a like way.

With respect to Claims 18 and 29, they are the article and system forms of Claim 3 respectively and are rejected in a like way.

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With respect to Claims 20 and 31, they are the article and system forms of Claim 5 respectively and are rejected in a like way.

With respect to Claims 24 and 35, they are the article and system forms of Claim 9 respectively and are rejected in a like way.

Claims 6, 8, 13-14, 21, 23, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0083156 A1 *Schultze*.

Concerning Claim 6, see the discussion of Claim 5. *Schultze* does not specifically disclose a discard rule for discarding a response based on response attribute data. Official Notice is taken that it was old and well known at the time of the invention to process responses based on their attributes. For example, a potential borrower's response to a loan questionnaire would provide a basis for deciding what decision was made regarding a loan. A response having deficient attributes (household income too low) would not result in a loan. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Schultze* to discard responses having certain deficient attributes because this would save persons reviewing responses from wasting time on responses having no interest.

Regarding Claim 8, see the discussion of Claim 6; a discarding rule is read as a processing rule.

With respect to Claim 13, *Schultze* does not specifically disclose user input to associate a compliance rule with a later-created opportunity; *Schultze* does however suggest this limitation. At paras. 22-24, *Schultze* discloses rules profiles. The commonly understood use of a profile is to prepare it and then subsequently use the profile repeatedly. This interpretation meets the

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essence of the limitation. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Schultze* to reuse the rules profiles disclosed to save users the need of repeatedly entering the same rules for each new opportunity. **As to Claim 14**, it would likewise have been obvious to automatically associate rules to later opportunities because this would further reduce user effort.

With respect to Claims 21 and 32, they are the article and system forms of Claim 6 respectively and are rejected in a like way.

With respect to Claims 23 and 34, they are the article and system forms of Claim 8 respectively and are rejected in a like way.

Claims 4, 7, 19, 22, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0083156 A1 *Schultze* in view of US 2002/0165814 A1 *Lee et al.*

With respect to Claim 4, see the discussion of Claim 1. *Schultze* does not specifically disclose assignment of weight to a response. *Lee* discloses this limitation at paras. 44-46. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Schultze* to include the response weighting disclosed by *Lee* because this would provide a provide an more effective procedure for evaluation of seller bids having two or more attributes. See *Lee* at Summary of the Invention.

Regarding Claim 7, see the discussion of Claim 4. *Schultze* does not specifically disclose a weighting rule for weighting a response based on response attribute data. *Lee* discloses this limitation at paras. 31-35. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Schultze* with the weighting rules for attributes of

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Lee because this would result in improved ranking of alternative responses. See *Schultze* at Summary of the Invention.

With respect to Claims 19 and 22, they are article forms of Claims 4 and 7 and are rejected in a like manner.

With respect to Claims 30 and 33, they are system forms of Claims 4 and 7 and are rejected in a like manner.

Claims 10, 25 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0083156 A1 *Schultze* in view of US 2003/0208424 A1 *Tenorio et al.*

With respect to Claim 10, see the discussion of Claim 1. *Schultze* does not specifically disclose evaluation based where the attribute is supplier identification. *Tenorio* discloses this limitation in a trading environment at para. 21. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Schultze* to include the supplier identification evaluation of *Tenorio* because this would allow buyers to receive responses from appropriate suppliers, such as those of a particular geographic area. See *Tenorio* at para. 21, lines 1-8.

With respect to Claims 25 and 36, they are the article and system forms of Claim 10 respectively and are rejected in a like way.

Claims 11, 26 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0083156 A1 *Schultze* in view of US 2002/0165814 A1 *Lee et al* and further in view of US 2003/0208424 A1 *Tenorio et al.*

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With respect to Claim 11, see the discussions of Claims 4 and 10. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Schultze* with weighted supplier identification because this would result in improved ranking of qualified supplier responses.

With respect to Claims 26 and 37, they are the article and system forms of Claim 10 respectively and are rejected in a like way.

Conclusion

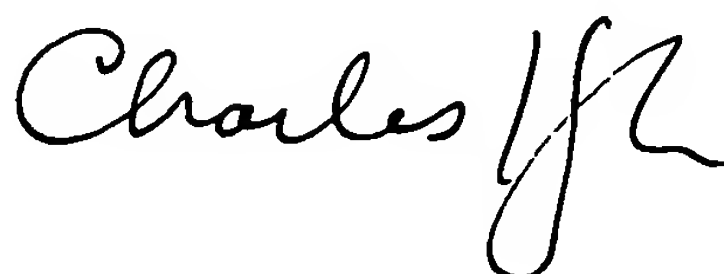
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
November 18, 2004

Examiner Charles Kyle

A handwritten signature in cursive script, appearing to read "Charles Kyle", written in black ink.